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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,524	10/10/2001	Christopher R. Vincent	POU920010113US1	1514

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EXAMINER

BADII, BEHRANG

ART UNIT PAPER NUMBER

3621

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/976,524

Applicant(s)

VINCENT, CHRISTOPHER R.

Examiner

Behrang Badii

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 8/18/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5-9, 16-20, 27-31 and 34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-9, 16-20, 27-31 and 34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### ***Response to Arguments***

Applicant's arguments filed 8/18/05 have been fully considered but they are not persuasive. The words specified and limited can be interpreted to have the same meaning, however Serbinis et al, discloses "If the number of retries exceeds the predetermined limit, the notification request flag is set to "failed" at step 227, and the notification transaction is logged as "failed," at step 228." (col.20, 16-25). All other claims depend on claims 5, 16 and 27.

#### **2112 [R-2] Requirements of Rejection Based on Inherency; Burden of Proof**

The express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103. "The inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness." In re Napier, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995) (affirmed a 35 U.S.C. 103 rejection based in part on inherent disclosure in one of the references). See also In re Grasselli, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983).

New claim 34 is discussed below.

### **DETAILED ACTION**

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 5-9, 16-20 & 27-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Serbinis et al., U.S patent 6,314,425.

As per claims 5, 16 & 27, Serbinis et al. discloses a method/system/computer readable medium of controlling access to data on a computer (abstract), the method comprising:

accepting a request for a data item, wherein the request contains a nonce value, wherein the nonce value comprises a token that is only accepted for a specified (predetermined limit) (col.20, 16-25) number of requests (col.3, 57-67; col.4, 1-4; col.20, 16-25; The tokens are used to limit the user's access);

determining that the nonce value is valid and has been accepted for fewer than the specified number of requests (col.4, 66-67; col.5, 1-19; col.3, 57-67; col.4, 1-4; col.20, 16-25; Validating the token and limiting the amount of time the token can request to use the system/data.); and

responding to the request by returning the data item in response to the determining that the nonce value is valid and accepted for fewer than the specified number of requests (abstract; col.3, 57-67; col.4, 1-4; col.20, 16-25; Returning the data after the token has been validated and before the expiration time of the token, limiting the number of times the token can be used to request data from the system).

As per claims 6, 17 & 28, Serbinis et al. discloses charging (billing) an entity in response to retuning the data item the step in conjunction with the use of the nonce (token) value (col.15, 30-38).

As per claims 7, 18 & 29, Serbinis et al. discloses wherein the nonce (token) value comprises an expiration time and wherein the determining further determines that the nonce (token) value has not expired (col.21, 19-26).

As per claims 8, 19 & 30, Serbinis et al. discloses wherein the determining that the nonce value is valid and accepted for fewer than the specified number of requests further comprises comparing the nonce value to a list of stored and valid nonce values (comparing the token to a list for validation) (col.21, 30-51).

As per claims 9, 20 & 31, Serbinis et al. discloses wherein the list of stored and valid nonce values is shared with an entity that originated the data request (file sharing, and the token value (data) are in those files) (abstract; col.2, 43-49).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Serbinis et al., U.S. patent 6,314,425 as applied to claim 5 above, and further in view of Khater, U.S. patent application publication 2002/0184143 or Pisarsky 2002/0147838.

As per claim 34, Serbinis et al. discloses a method/system/computer readable medium of controlling access to data on a computer as discussed above. Serbinis et al. does not disclose wherein the nonce value is only accepted one time, and wherein the responding to the request is performed in response to the nonce value having not been previously accepted (code/password can only be used once; request is only accepted one time). Khater or Pisarsky disclose wherein the nonce value is only accepted one time, and wherein the responding to the request is performed in response to the nonce value having not been previously accepted (code/password can only be used once; request is only accepted one time) (Khater, p16) (Pisarsky, p5). It would have been obvious to modify Serbinis et al. to include wherein the nonce value is only accepted one time, and wherein the responding to the request is performed in response to the nonce value having not been previously accepted (code/password can only be used once; request is only accepted one time) such as that taught by Khater or Pisarsky in order to reject any double usage of the code hence improving the security of the system since a after the code is used a new code has to be generated for the next request to go through the system.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Corbin (U.S. patent 5,138,712) discloses an apparatus and method for licensing software on a network of computers.

Norris (U.S. patent 6,718,328) discloses a system and method for providing controlled and secured access to network resources.

Lau et al. (U.S. patent 6,182,124) discloses a token-based deadline enforcement system for electronic document submission.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Behrang Badii whose telephone number is 571-272-6879. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Any response to this action should be mailed to:**

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Hand delivered responses should be brought to

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 3600 Customer Service Office whose telephone number is **(703) 306-5771**.

Behrang Badii  
Patent Examiner  
Art Unit 3621

BB

*Behrang Badii*  
PRIMARY EXAMINER